

THE REMARKS

The Amendments

The specification has been amended to delete reference to the leader for reference no. 127.

Figure 1 has been amended to identify the drawing as prior art.

Claims 1, 3, 12-13, 19-20, 29, 24, 32, 34-35, 40 and 41 have been amended to overcome rejections and correct dependency. Support for amendments can be found in *e.g.*, Claims 2-3, 11, 20, 21, 24, 31, 33 and page 13, line 16.

Claims 25-26 and 28 have been amended to correct antecedent basis.

Claims 2, 11, 20, 31 and 33 have been canceled.

Applicant submits that no new matter is introduced by the proposed amendment and respectfully requests entry thereof.

The Response

35 U.S.C. § 112 Rejection

Claims 25-26 and 28 have been rejected under 35 U.S.C. § 112 as allegedly lacking antecedent basis. Applicants have amended Claims 25-26 to correctly depend from Claim 24 which provides antecedent basis for ‘said second outlet’

Claim 19 has been amended to provide antecedent basis for ‘said first bypass’ in amended Claim 28.

Formal Drawings

Figure 1 has been amended to add the legend ‘Prior Art’ to indicate that only which is old is illustrated.

Examiner alleges that the leader for reference no. ‘127’ does not indicate a label. Applicants have amended the specification to remove leader no. ‘127’ in reference to Figure 8.

35 U.S.C. § 102 Rejection

Claims 1-7, 10, 19-23 and 29-32 and 40-43 have been rejected under 35 U.S.C. § 102 (b) as allegedly being anticipated by Buckley U.S. Patent No. 543,922. Buckley discloses a downspout filter apparatus with removable drawers. Applicants have amended independent Claims 1, 19, 29 and 40-41 to recite apparatus and methods that provide a bypass to provide an alternative route for fluid to pass. No bypass mechanism is taught or suggested by Buckley. Applicants maintain that in view of amendments to independent Claims 1, 19, 29 and 40-41, Buckley does not teach each and every element of the noted claims.

Claims 1-3, 5-7, 10, 14-15 18-21, 23-24, 29-32, 36 and 39-44 have been rejected under 35 U.S.C. § 102 (b) as allegedly being anticipated by Minnemeyer (U.S. Patent No. 522,667). Minnemeyer discloses a strainer for conductor pipes that provides a strainer to be placed in a rigid line of conductor pipe. Applicants have amended independent Claims 1, 19, 29 and 40-41 to recite apparatus and methods that provide a bypass to provide an alternative route for fluid to pass. No bypass mechanism is taught or suggested by Minnemeyer. Applicants maintain that in view of amendments to independent Claims 1, 19, 29 and 40-41, Minnemeyer does not teach each and every element of the noted Claims.

Claims 1-2, 5-7, 10-12, 19-20, 23, 29-30, 33-34 and 40-43 have been rejected under 35 U.S.C. § 102 (b) as allegedly being anticipated by Hubert (U.S. Patent 3,628,668). Hubert discloses leader pipe attachment with a screen in the pipe section. Applicants have amended independent Claims 1, 19, 29 and 40-41 to recite apparatus and methods that provide one or more fluid treatment elements, wherein at least one of the one or more fluid treatment elements comprises a filter basket. No filter basket is taught or suggested by Hubert. Applicants maintain that in view of amendments to independent Claims 1, 19, 29 and 40-41, Hubert does not teach each and every element of the noted Claims.

Claims 1-2, 5-7, 10-12, 14-15, 18-20, 23-24, 29-31, 33-34, 36 and 39-44 have been rejected under 35 U.S.C. § 102 (e) as allegedly being anticipated by Doiron (U.S. Patent 6,619,312). Doiron discloses flow control mechanism with a debris screen. Applicants have amended independent Claims 1, 19, 29 and 40-41 to recite apparatus and

methods that provide one or more fluid treatment elements, wherein at least one of the one or more fluid treatment elements comprises a filter basket. No filter basket is taught or suggested by Doiron. Applicants maintain that in view of amendments to independent Claims 1, 19, 29 and 40-41, Doiron does not teach each and every element of the noted Claims.

Claims 1-2, 5-7, 10-12, 14-15, 18-20, 23-24, 29-31, 33-34, 36 and 39-44 have been rejected under 35 U.S.C. § 102 (e) as allegedly being anticipated by Walker (U.S. Patent 971,578). Walker discloses a rain water cut-off. Applicants have amended independent Claims 1, 19, 29 and 40-41 to recite apparatus and methods that provide one or more fluid treatment elements, wherein at least one of the one or more fluid treatment elements comprises a filter basket. No filter basket is taught or suggested by Walker. Applicants maintain that in view of amendments to independent Claims 1, 19, 29 and 40-41, Walker does not teach each and every element of the noted claims.

For at least the foregoing reasons, Buckley, Minnemeyer, Huppert, Doiron, and Walker fails to teach or suggest every material element of amended independent Claims 1, 19, 29 and 40-41. Since Claims 2-7, 10-12, 14-16, 18 depend from Claim 1; Claims 20-26, and 28 depend from Claim 19; Claims 30-37 and 39 depend from Claim 29 and Claims 42-44 depend from Claim 41, the noted references similarly fails to anticipate these claims as well. Applicant respectfully submits that Claims 1-7, 10-12, 14-16, 18-26, 28-37 and 39-44 are patentable over Buckley, Minnemeyer, Huppert, Doiron, and Walker.

35 U.S.C. § 102/103 Rejection

Examiner rejects Claims 8-9 under 35 U.S.C. § 102(a)/103(a) as allegedly being unpatentable over Buckley, Minnemeyer, Huppert, Doiron, and Walker. In particular, the Examiner states that the references teach a product that appears to be the same as the product set forth in a product-by-process claim although a product by a different process. Applicant submits that the Office Action fails to set forth a *prima facie* case of obviousness. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *See* MPEP § 2143.03. Amended Claim 1 recites, *inter alia*: An apparatus, comprising: one or more fluid treatment

elements adapted to treat fluid passing through said apparatus, at least one of said one or more fluid treatment elements disposed at a location between said first inlet and said first outlet, wherein at least one of said one or more fluid treatment elements comprises a filter basket and a bypass, said primary bypass adapted to provide a first alternative route for fluid to pass through said apparatus.

For at least the foregoing reasons, the references above fail to teach or suggest every material element of amended Claim 1. Since Claims 8 and 9 depend from Claim 1, the references similarly fail to anticipate these claims as well. Applicant respectfully submits that Claims 8-9 are patentable over all of the above references.

35 U.S.C. § 103 Rejection

Examiner rejects Claims 17, 27, and 38 are under 35 U.S.C. § 102(a)/103(a) as allegedly being unpatentable over Buckley, Minnemeyer, Huppert, Doiron, and Walker, in view of Macpherson *et al.* (U.S. Patent 6,821,427). In particular, the Examiner states that Macpherson *et al.* teach chitosan gel for treating storm water. Applicant submits that the Office Action similarly fails to set forth a *prima facie* case of obviousness. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *See* MPEP § 2143.03. Amended Claims 1, 19 and 29 recite, *inter alia*: An apparatus or downspout filter, comprising a filter basket and a bypass.

For at least the foregoing reasons, the references above fail to teach or suggest every material element of amended Claims 1, 19 and 29. Since Claims 17, 27 and 38 depend from Claims 1, 19 and 29 respectively, the references similarly fail to anticipate these claims as well. Applicant respectfully submits that Claims 17, 27 and 38 are patentable over all of the above references in view of Macpherson.

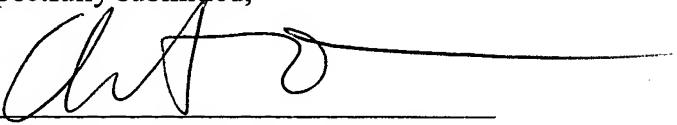


Appl. No. 10/724,275
Allard *et al.*

CONCLUSION

Applicant believes that the application is in good and proper condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is encouraged to call the undersigned at (650) 798-3547.

Respectfully submitted,



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